

REMARKS/ARGUMENTS

Claims 1-16 and 20 are pending and stand rejected. Applicant respectfully traverses all rejections and requests reconsideration in view of the present amendments and remarks.

Claim Amendments

Amendments to step (c) of Claim 14 have basis in the Application as filed and do not constitute new matter. Specifying that the composite web comprises a low binder fiber mat and a support mat has support from the definition of a composite web (*see, e.g.*, page 4, lines 8-10).

These amendments serve the purpose of more clearly defining limitations already present in the claims and do not serve to further limit the claims in any way for patentability.

Rejection Under 35 USC 112

Claims 14-16 stand rejected under 35 USC 112 for being indefinite. The Office suggests that “the composite web’s support mat” does not have a positive antecedent basis and that it is unclear to what “its” refers. Applicant believes that both phrases are clear from the definition of “composite web” and the sentence structure of Claim 1. Nonetheless, in order to promptly advance prosecution, Applicant presents the current amendments to Claim 14 which further clarify the phrases at issue and obviate the basis for rejection.

Rejections Under 35 USC 103(a)

Claims 1-16 and 20 stand rejected as being obvious over Londrigan et al (US 5,837,743, “Londrigan”) in view of Hoffmann et al (US 4,808,425, “Hoffmann”) and, for the same reasons, over Gluck et al (US 4,572,865, “Gluck”) in view of Hoffman.

The Office suggests that each of Londrigan and Gluck disclose all elements of the presently claimed invention except use of a composite laminate from a roll. The Office points to Hoffman to create a roll of composite laminate. The Office concludes that because Hoffman contains a mesh web with a facing material in a single roll it is obvious to combine a low binder fiber mat and a support mat into a laminate on a single roll in the process of Londrigan and Gluck. As motivation to modify Londrigan and Gluck, the Office asserts that the modification offers a “self-evident advantage of

simplifying the process" by eliminating feed rollers and a need to synchronize feed speeds.

Applicant believes that the basis for the Office's obviousness rejections under 35 USC 103(a) is insufficient for at least three reasons. First, the proposed modification addresses a difference between the presently claimed invention and the primary references but falls short of addressing the claimed invention as a whole. Second, the motivation to combine and modify references to achieve the presently claimed invention lacks the specificity and objectivity necessary to support even a *prima facie* case of obviousness. Finally, in regards to Claim 20, the Office has not presented any motivation for further modifications to the primary reference necessary for the process of the primary references to meet the limitations of Claim 20 of the present Application (elimination of rollers contacting the top of the composite web). Applicant addresses each of these apparent deficiencies in detail below.

(1) Failure to Consider Claim as a Whole

When considering a difference between prior art and a claimed invention, the Office must consider the claim as a whole. (*see*, MPEP 2141.02). In considering the claim as a whole the Office must consider whether Applicant has identified a problem's source and offered a solution different from solutions offered for a similar problem in prior art. Discovery of the source of a problem may render an invention patentable even though the remedy may be obvious once the source of the problem is identified. (*In re Sponnable* as quoted in MPEP 2141.02, third section). However, an invention may not be patentable if the solution is obvious from prior art that contains the same solution for a similar problem. (*In re Wiseman*, quoted in MPEP 2141.02, third section).

Applicant has discovered a solution to specific problems with feeding low binder fiber mat into a foaming process. The problems include necking of low binder fiber mats, pulling apart of low binder mats upon unrolling and fouling of rollers which contact low binder mats. Applicant has identified the source of these problems as being: (i) stretching of low binder mats when unrolling and feeding into a foaming process, which causes the necking and ridging; (ii) the fact that low binder mat contacts and adheres to itself in supply rolls thus causing it to pull apart upon

unrolling; and (iii) the fact that low binder mat contacts rollers in typical processes whereupon the fibers may remain with the rollers and foul them. Applicant articulates these problems and the fact the present invention is a solution to those problems on page 4, lines 16-22 of the present Application.

The combination of the problems Applicant addresses is quite specific to the use of low binder fiber mat. As in Sponnable, Applicant has discovered the source of these problems (stretching of the mat, contact with itself in roll form and contact with rollers in typical processes) and further discovered a solution to the problems – use of a composite web and avoiding contact of low binder fiber mat with rollers.

Unlike in Wiseman, none of the cited references even acknowledges these problems, let alone offers a similar solution. The process of Londrigan and Gluck should suffer from the very problems Applicant resolves since the references disclose a process that feeds a reinforcing mat from a separate roll than the facing sheet and further illustrates contacting the reinforcing mat with rollers. Hoffman also fails to identify the particular problem and solution of the present invention. Hoffman seeks to solve a problem with bubbles forming in foam-facer laminates (*see*, column 1, line 67 through column 2, line 2) and does so by using a “meshwork” web instead of a “reinforcing” web (*see*, column 2, lines 26-29). The problem of Hoffman is unrelated to the problem addressed by the present invention and the solution of Hoffman is unrelated to the solution of the present invention. Since none of the cited references appreciates the problem identified by Applicant, none of the cited references identifies the source of the problems as does Applicant, and none of the cited references provides a solution those problems as does Applicant, Applicant believes the presently claimed invention as a whole is non-obvious over the cited references per MPEP 2141.02 and the case law cited therein.

(2) Motivation to Combine/Modify Lacking Specificity and Objectivity

The motivation to combine or modify either Londrigan or Gluck with Hoffman set forth by the Office is insufficient to establish a *prima facie* case of obviousness.

A *prima facie* case of obviousness requires three elements: (1) suggestions or motivation to modify or combine reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim

limitations. (*see*, MPEP 2142). In regards to the suggestion or motivation to modify or combine reference teachings, broad conclusory statements regarding the teaching of multiple references, standing alone, does not establish “evidence” of a suggestion, teaching or motivation to combine those references. Mere reference to “common knowledge” or “common sense” is insufficient to establish motivation to combine references – motivation to combine must be based on specific objective evidence and conclusory statements fail to fulfill the agency’s obligation. (*see*, In re Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) and abundance of references cited therein).

The Office’s motivation for combining the cited references is a broad conclusory statement that is neither objective nor specific. Alleging that a combination offers a “self-evident advantage of simplifying a process” is akin to stating the combination stems from “common knowledge” or “common sense.” While the Office provides specific advantages that may arise from the cited combination (fewer feed rollers and no need to synchronize feeds) – the Office fails to establish that such advantages are indeed a simplification of the process.

“Simplification” is a subjective term that requires rendering something less complicated. Upon viewing only Londigan, Gluck and Hoffmann, one of ordinary skill in the art may just as readily conclude that it is self-evident that combining the low binder fiber mat and support mat disadvantageously complicates the process by limiting process versatility and increasing uncertainty about composite web availability. Versatility limitations include having to replace an entire laminate in order to change a single component of the laminate rather than simply replacing a roll of that single component (an artisan must fabricate a completely new laminate rather than replace a single component roll). Furthermore, process complications arise in finding a supplier for rolls of specific laminate compositions – leading to cost and availability complications.

If, as the Office suggests, combining two feed lines into a single feed line offers a self-evident advantage of simplification there would seldom be a need for any process using multiple feed lines to form laminates, artisans would feed the laminate from a single roll. Clearly, and in conflict with the Office’s assertion, processes exist with multiple feed lines. Consider Londigan, which was filed 8 years after the issuance of Hoffman and 11 years after the issuance of Gluck, yet Londigan still

teaches only multiple feed lines despite the “self-evident advantage of simplifying the process” available to the inventors for 8 years through the combination of Hoffman and Gluck. The mere existence of processes with multiple feed lines that create laminate structures suggests combining such feed lines does not always offer a “self-evident advantage of simplifying the process.”

Since those of ordinary skill in the art would not necessarily consider the modification proposed by the Office a “simplification”, they would not necessarily be motivated to “simplify” the process of Londrigan or Gluck by such a modification. The Office offers no specific objective evidence (required per Lee) to support their claim that one of ordinary skill in the art would consider their proposed modification as a “simplification” at all. To simply assert that it is “self-evident” that the proposed modification of Londrigan and Gluck constitutes a simplification that would motivate the modification is insufficient – particularly in view of arguments to the contrary. As such, the proposed motivation to combine and modify teachings of the cited references does not satisfy the Office’s burden to provide motivation to modify or coming references so a case for *prima facie* obviousness fails.

(3) Motivation to Combine/Modify to Achieve Claim 20

The Office asserts that the limitation of Claim 20 requiring that the low binder fiber mat not contact any rollers naturally flows from the modified process of Londrigan and Gluck. Applicant respectfully disagrees. Accepting, for the sake of argument: (1) a process using a composite web laminate comprising a low binder fiber mat and a support mat; and (2) that it would have been imperative to orient the composite web with the support mat below the low binder fiber mat as the Office states, both the Londrigan and Gluck processes would still contact the low binder fiber mat with at least one roller. The process illustrated in Londrigan and Gluck has rollers contacting both the top and bottom surface of each feed material. To meet the limitation of Claim 10, one must further modify Londrigan and Gluck to eliminate feed rollers by redesigning the feed system. The Office fails to address such a modification, let alone identify any motivation for such a modification. At best, the Office provides a conclusion than the modification “naturally flow[s]” from the modified processes of Londrigan and Gluck. Applicant refers to the rules and

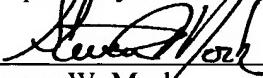
argument presented above which establish that a motivation sufficient to establish *prima facie* obviousness must be more than a broad, subjective conclusory statement (*see*, discussion above under ***Motivation to Combine/Modify Lacking Specificity and Objectivity***). Applicant contends that the Office's assertion that the limitation of Claim 20 "naturally flow[s]" from the modified process is a broad, subjective conclusory statement that is insufficient to establish *prima facie* obviousness.

Anticipating that the Office may simply state a motive similar to that offered in the rejection of Claims 1-16, Applicant further contends that "simplification" of the process is an insufficient motive for eliminating rollers in the Londrigan and Gluck processes due to the breadth, lack of specificity and subjectivity of "simplification." Elimination of rollers in Londrigan and Gluck may actually complicate the process by, e.g., causing tension control of the webs to become more difficult.

Conclusion

Based on the present amendments and remarks, Applicant believes the presently claimed invention is patentable over the cited references. The Office appears to have neglected to consider the claimed invention as a whole by not considering the fact that Applicant identified problems, sources for the problems, and a solution to the problems unlike any other solutions to similar problems offered by cited prior art. Furthermore, the motives for combinations and modifications asserted by the Examiner are conclusory, broad and subjective – which renders them insufficient to support a *prima facie* case of obviousness. Applicant respectfully requests that the Examiner reconsider the present claims in view of these amendments and remarks and that the Examiner withdraw the pending rejections and issue a notice of allowance for Claims 1-16 and 20 at an early date.

Respectfully submitted,



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